



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,784	11/07/2001	Michiko Fukuda	15056	7912

23389 7590 06/22/2005

SCULLY SCOTT MURPHY & PRESSER, PC  
400 GARDEN CITY PLAZA  
SUITE 300  
GARDEN CITY, NY 11530

EXAMINER

ENG, GEORGE

ART UNIT	PAPER NUMBER
----------	--------------

2643

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/043,784

Applicant(s)

FUKUDA, MICHIKO

Examiner

George Eng

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-8, 11-16 and 19-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-8, 11-16 and 19-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/19/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office action is in response to the amendment 10/19/2004. Accordingly, claims 1-2, 9-10 and 17-18 are canceled and claims 3-8, 11-16 and 19-30 are pending for examination.

### ***Information Disclosure Statement***

2. The information disclosure statement filed 10/19/2004 has been considered.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-8, 11-16 and 19-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kadowaki et al. (US PAT. 5,414,457) in view of Schwartz (US PAT. 5,872,923 hereinafter Schwartz).

Regarding claim 3, Kadowaki discloses a telephone unit as shown in figure 4 having a telephone directory with picture data comprising video interface (10, figure 3) for receiving compressed image data from a distant station (col. 3 lines 34-35), decoding means (20) for decoding the received compressed image data into an image signal (col. 3 lines 31-32),

Art Unit: 2643

correlating means (50, figure 3) for correlating the image signal with a telephone number of the distant station (col. 4 lines 4-6), and registering means (41, figure 1) for registering the image signal and the telephone number with the telephone directory (col. 4 line 48 through col. 6 line 17). Kadowaki differs from the claimed invention in not specifically teaching receiving compressed moving picture data from the distance party so that first decode means decodes the compressed moving picture data and encoding means encodes one or more frames of the decoded moving picture data into compressed still picture data in order to register the still picture data generated by said encoding means, wherein the still picture data generated by the encoding means is in conformity with a still picture format which is different from a moving picture format with which the moving picture data is in conformity, and wherein the compressed still picture and the telephone number are registered with the telephone directory in JPEG format, the telephone number being recorded in a comment segment of a JPEG file. However, Schwartz teaches a system capable of allowing a user using a mouse to capture a current video frame on a display and to encode the captured from into a JPEG format in order to stored the capture image as a record in a database (col. 12 lines 26-67). In addition, Schwartz also teaches each record comprising multiple fields, which having the captured image and a telephone directory (col. 13 line 2 through col. 14 line 17) so that one skill in the art would recognize Schwartz teaching the captured image and the telephone number being stored in a same file so that the telephone number is recorded in a comment segment of JPEG file, thereby allowing direct capture of video stream in database. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Kadowaki in receiving compressed moving picture data from the distance party so that first decode means decodes the compressed moving picture

data and encoding means encodes one or more frames of the decoded moving picture data into compressed still picture data in order to register the still picture data generated by said encoding means, wherein the still picture data generated by the encoding means is in conformity with a still picture format which is different from a moving picture format with which the moving picture data is in conformity, and wherein the compressed still picture and the telephone number are registered with the telephone directory in JPEG format, the telephone number being recorded in a comment segment of a JPEG file, as per teaching of Schwartz, because it allows direct capture of video stream in database.

Regarding claim 4, the limitations of the claim are rejected as the same reasons set forth in claim 3.

Regarding claim 5, Kadowaki discloses a telephone unit as shown in figure 4 having a telephone directory with picture data comprising video interface (10, figure 3) for receiving compressed image data from a distant station (col. 3 lines 34-35), decoding means (20) for decoding the received compressed image data into an image signal (col. 3 lines 31-32), correlating means (50, figure 3) for correlating the image signal with a telephone number of the distant station (col. 4 lines 4-6), and registering means (41, figure 1) for registering the image signal and the telephone number with the telephone directory (col. 4 line 48 through col. 6 line 17). Kadowaki differs from the claimed invention in not specifically teaching receiving compressed moving picture data from the distance party so that first decode means decodes the compressed moving picture data and encoding means encodes one or more frames of the decoded moving picture data into compressed still picture data in order to register the still picture data generated by said encoding means, wherein the still picture data is selected by selecting

means in response to an operation by a user and the still picture data generated by the encoding means is in conformity with a still picture format which is different from a moving picture format with which the moving picture data is in conformity. However, Schwartz teaches a system capable of allowing a user using a mouse, i.e., selection means, to capture a current video frame on a display and to encode the captured frame into a JPEG format in order to store the captured image as a record in a database (col. 12 lines 26-67), in order to make user friendly. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Kadowaki in receiving compressed moving picture data from the distant party so that first decode means decodes the compressed moving picture data and encoding means encodes one or more frames of the decoded moving picture data into compressed still picture data in order to register the still picture data generated by said encoding means, wherein the still picture data is selected by selecting means in response to an operation by a user and the still picture data generated by the encoding means is in conformity with a still picture format which is different from a moving picture format with which the moving picture data is in conformity, as per teaching of Schwartz, in order to make user friendly.

Regarding claim 6, Kadowaki discloses second display means as shown in figure 2 for displaying the decoded still image data decoded by decoding means (col. 6 lines 15-34 and col. 5 line 9-38).

Regarding claim 7, Kadowaki teaches to display the decoded still picture when originating a call to the distant station (col. 5 lines 9-23).

Regarding claim 8, Schwartz teaches to restore the decoded still picture for reproducing after communication ends (col. 14 lines 2-12).

Art Unit: 2643

Regarding claims 11-12, the limitations of the claims are rejected as the same reasons set forth in claim 3.

Regarding claim 13, the limitations of the claim are rejected as the same reasons set forth in claim 5.

Regarding claims 14-16, 19-21, 22-24, 25-27 and 28-30, the limitations of the claims are rejected as the same reasons set forth in claims 6-8, respectively.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 3-8, 11-16 and 19-30 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

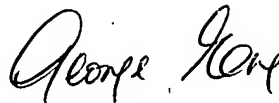
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Morita discloses a portable having a phone-book capability of storing and searching plural of receiver information including character information and image information (col. 2 line 27 through col. 5 line 44). De Boor et al. (US PAT. 6,470,381) discloses a wireless communication device with a markup language based man-machine interface providing a user interface for telecommunications functionality (abstract).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is (571) 272-7495. The examiner can normally be reached on Tue-Fri 7:30 AM-6:00 PM.

Art Unit: 2643

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "George Eng".

George Eng  
Primary Examiner  
Art Unit 2643